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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,583	07/24/2003	Kenichi Hayashi	240708US2	7738
22850	7590	11/21/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WILLIAMS, ALEXANDER O	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,583

Applicant(s)

HAYASHI ET AL.

Examiner

Alexander O. Williams

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Application/Control Number: 10/625,583
Art Unit: 2826

Page 2

Serial Number: 10/625583 Attorney's Docket #: 240708US2
Filing Date: 7/24/2003; claimed foreign priority to 7/26/02

Applicant: Hayashi et al.

Examiner: Alexander Williams

Applicant's Amendment filed 8/21/06 to the allowance filed 10/3/05 to the election with traverse of species of figure 1A (claims 1-8, 15, 18 and 19) filed 10/18/04 is acknowledged. This species elected read on figures 1A to 7.

This application contains claims 9-14, 16, 17 and 20 drawn to an invention non-elected with traverse.

Claim 19 has been cancelled.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of leads protruding outward from said plastic package, **each of said leads being joined to a heat sink in said plastic package** in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.101(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-8, 15 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear and confusing to what is meant by and what shows "a plurality of leads protruding outward from said plastic package, **each of said leads being joined to a heat sink or located near the heat sink in said plastic package.**" Also, the claim language of "**each of said leads being joined to a heat sink or located near the heat sink in said plastic package**" recite alternative structures. The phrase "located near the heat sink" is unclear to what is considered near. Any element within the package can be considered to be near any other element in the package.

Any of claims 1-8, 15 and 18 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, and with respect to claims 8, 15 and 18, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claims 1 to 8, 15 and 18, **insofar as claim 1 can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito Takehiro (Japan Patent # 63-166254) in view of Honda et al. (U.S. Patent # 6,849,805 B2).

1. Saito Takehiro (figures 1 to 6) specifically figures 3 and 4 show a semiconductor device of an insertion-mount-type comprising: a plastic package **1**; a plurality of leads **2**

protruding outward from said plastic package; one or more semiconductor elements **(within the 1)** protected by said plastic package; and electric wiring **(inherent)** protected by said plastic package to connect said semiconductor elements with said leads, said semiconductor device being mounted on an external electric member **21** by inserting said leads into a lead-inserting portion **22** of said external member and joining said leads with said lead-inserting portion by solder **23**, at least one of said semiconductor elements being a power semiconductor element (inherent), wherein each of said leads includes a first lead portion **(portion of 2 closest to the package with first wide width portion)** located at a plastic package side, a second lead portion **(portion of 2 after first lead wide width portion to the beginning portion of the second wide width portion)** located at a position closer to a lead tip end than said first lead portion, and a third lead portion **(portion at the outer end of the lead 2 at the tip after the second wide width portion)** located at a position closer to the lead tip end than said second lead portion, the third lead portion being capable of being inserted into a lead-inserting portion, the sectional area of said second lead portion is set to a value smaller than that of said first lead portion, and at least some of said leads are formed as gap controlling leads provided with gap-controlling means **(portion of 2 with the second wide portion)** to keep a gap between said semiconductor device and said external electric member constant by inserting at least some of the third lead portions being capable of being put into said external electric member up to said gap-controlling lead, said gap-controlling means being located at a position closer to the lead tip end than said second lead portion, but fail to explicitly show each of said leads being coated with solder using tin as a base material without containing lead on outside of said plastic package and each of said leads being joined to a heat sink or located near the heat sink in said plastic package.

Honda et la. Is cited for showing a printed circuit board and electronic apparatus. Specifically, Honda et al. (figures 1 to 9) specifically figure 1 discloses a semiconductor device being to be mounted on an external electric member **1** by inserting said leads **2** into a lead inserting portion **5** of said external electric member and each of said leads being coated with solder **7** using tin as a base material without containing lead on outside of said plastic package and each of said leads **2** being joined to a heat sink **6** or located near the heat sink **6** in said plastic package for the purpose of providing

Art Unit: 2826

exceedingly economical means for connection of integrated circuits selectively in readily removeable or permanent soldered attachment.

(2) 1. Field of the invention

(3) This invention relates to a printed wiring board which is capable of preventing the occurrence of lift-off and land peeling at soldered portions when a component to be mounted on the printed wiring board (hereinafter referred to as the "inserted component") is soldered by using solder, in particular lead-free solder, and an electronic apparatus such as a printer in which is installed the printed wiring board.

(6) However, the high-temperature-type lead-free solders that are currently most commonly used are composed mainly of Sn and Ag, and have a melting point of about 220.degree. C. If flow soldering of an inserted component is carried out using such a high-temperature-type lead-free solder, then solidification of the solder, which is accompanied by solidification shrinkage, proceeds from the vicinity of the inserted component, which has good thermal conductivity, towards the vicinity of the printed wiring board, and hence the solder joint interface at the part of the surface of the substrate on which the inserted component is mounted in particular becomes the final solidified part, resulting in lift-off and land peeling.

(7) Moreover, when flow soldering is carried out using lead-free solder as described above, segregation of Pb contained in the surface-treated leads of the inserted component and segregation of elements (Bismuth, etc.) contained in the lead-free solder used in the flow soldering occur during the cooling process, and the physical properties of the solder changes during the cooling process. As a result, there is a problem that the occurrence of lift-off and land peeling is increased, and in the worst cases the land peeling is accompanied by breakage (i.e., electrical disconnection) of the pattern connected to the lands.

(4) FIG. 1 is a sectional view showing a printed wiring board according to a first embodiment of the present invention in a state in which inserted component leads 2 have been flow-soldered to the printed wiring board with lead-free solder. In the present embodiment and the other embodiments described below, elements and parts corresponding to elements and parts in

Art Unit: 2826

FIGS. 5 and 6, which show the conventional art described above, are designated by the same reference numerals as in FIGS. 5 and 6.

(7) In FIG. 1, a plurality of through holes 5 are formed in a substrate 1 of the printed wiring board, and a land 6 is formed over an inner peripheral surface of each through hole 5 and opposite end surface parts of the substrate 1 formed with each through hole 5. Inserted component leads 2 of an inserted component 3 such as an electronic component are inserted into the through holes 5 and flow-soldered to the substrate 1 with lead-free solder.

2. The semiconductor device according to claim 1, the combination with Saito Takehiro showing wherein said gap-controlling means is formed by making the lead width thereof locally larger than the width of said second lead portion.
3. The semiconductor device according to claim 2, the combination with Saito Takehiro showing wherein said leads are arranged in a line at a side portion of said plastic package, only said leads at both ends of said line being formed as said gap-controlling leads.
4. The semiconductor device according to claim 2, the combination with Saito Takehiro showing wherein the thickness of said first lead portion is equal to that of said second lead portion, the width of said second lead portion being smaller than that of said first lead portion.
5. The semiconductor device according to claim 2, the combination with Saito Takehiro showing wherein the sectional area of said second lead portion is equal to that of said third lead portion.
6. The semiconductor device according to claim 2, the combination with Saito Takehiro showing wherein said gap-controlling means is formed in a shape protruding to both directions along a lead width direction.
7. The semiconductor device according to claim 6, the combination with Saito Takehiro showing wherein the lead width of said gap-controlling means is equal to that of said first lead portion.
8. The semiconductor device according to claim 7, the combination with Saito Takehiro showing wherein each of said gap-controlling leads is formed by linearly cutting said lead frame having a wide portion corresponding to said first lead portion, a narrow portion corresponding to said second lead portion, and a tie bar portion which connects

Art Unit: 2826

said wide portion with said narrow portion and in which two holes are formed, and both of said holes are located at both sides of a range of said narrow portion along the lead width direction so that said holes are not present in said range, said holes being located on extension lines of both sides of said wide portion.

15. The semiconductor device according to claim 8, the combination with Saito Takehiro showing wherein each of said holes is a rectangular hole in which two opposite sides are parallel with the lead width direction or lead extending direction.

18. The semiconductor device according to claim 2, the combination with Saito Takehiro showing wherein each of said gap-controlling leads is formed by linearly cutting said lead frame having a wide portion corresponding to said first lead portion, a narrow portion corresponding to said third lead portion, and a tie bar portion which connects said wide portion with said narrow portion and in which two cutoff are formed at a position closer to said narrow portion, and said cutoffs are located at both sides of a range of said narrow portion in a lead width direction, said cutoffs being located on extension lines of both sides of said wide portion so as to be previously provided with said gap controlling means.

Therefore, it would have been obvious to one of ordinary skill in the art to use Honda et al.'s leads attachment and heat sink to modify Saito Takehiro's leads for the purpose of providing exceedingly economical means for connection of integrated circuits selectively in readily removeable or permanent soldered attachment.

As to the grounds of rejection under section 103, see MPEP § 2113.

Response

Applicant's arguments filed 8/21/06 have been fully considered, but are not found to be persuasive in view of the modified outstanding grounds of rejections detailed above. Honda et al. show each of said leads being located near the heat sink in said plastic package.

The insertion of Applicant's additional claimed language, for example, "in claim 1" cause for further search and consideration to make this action final.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Art Unit: 2826

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Field of Search	Date
U.S. Class and subclass: 257/666,696,698,691,690,693,692,776,775,787,673,672,671,670,e23.043 361/774,748,761,776,405 439/75 228/180 174/52.4	12/24/04 6/14/05 5/15/06 11/12/06
Other Documentation: foreign patents and literature in 257/666,696,698,691,690,693,692,776,775,787,673,672,671,670,e23.043 361/774,748,761,776,405 439/75 228/180 174/52.4	12/24/04 6/14/05 5/15/06 11/12/06
Electronic data base(s): U.S. Patents	12/24/04 6/14/05 5/15/06 11/12/06

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O Williams whose telephone number is (571) 272 1924. The examiner can normally be reached on M-F 6:30-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander O Williams
Primary Examiner
Art Unit 2826

AOW
11/12/06